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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/529,354	09/10/95	ELFISCHMAN	S 1928-D-CON

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EXAMINER

SHAY, D

ART UNIT PAPER NUMBER

3736

29

DATE MAILED: 09/17/98

This is a communication from the examiner in charge of your application  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on March 27, 1998 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                   |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____  |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-20, 28, 30, 32-40 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☒ Claims 21-27, 29, 31 have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 1-20, 28, 30, 32-40 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on \_\_\_\_\_, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 33-39 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Imran ('151).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20, 28, 30, 32 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houser et al in combination with Mackey et al .

Houser teaches a device as claimed except varying the electrodes between zones of uniform polarity and zones of alternating polarity. Mackey et al teach employing multiple poles of an ablating electrodes to control lesion size. It would have been obvious to the artisan of ordinary skill to control the ablation electrodes as claimed, since this would enable the efficient ablation of ectopic foci while also minimizing catheter exchanges; catheter manipulation; and time taken for the procedures, as taught by Mackey et al; to control the switching electronically,

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since it is obvious to make a manual function automatic; to configure the regions as helical strips or coatings, since these are well known configurations that provide <sup>or</sup> ~~to~~ unexpected result, and to <sup>or</sup> allow switching between AC and DC power, since this is not critical and provides no unexpected results, thus producing a device such as claimed.

Applicant argues that the added claim language defines over the combination. The examiner cannot agree, since Houser et al provide for the application of ablation energy using their device. Since in the <sup>vast</sup> ~~most~~ majority of cases, tissue contacting every single electrode of the <sup>or</sup> Houser et al device <sup>is</sup> ~~is~~ not going to need ablation, transmission must be blocked from some areas (electrodes) of the region while other areas (electrodes) transmit ablation energy. Thus this argument is not convincing.

Applicants arguments asserting that the references to Imran showing knowledge already present in the prior art as being a new rejection, since the previous rejection did not specifically mention "other knowledge in the prior art" is noted. This characterization of the rejection as new as flawed. The examiner noted that the substitution of a manual for an <sup>automatic</sup> ~~automatic~~ means is <sup>or</sup> obvious. It is not clear where the knowledge to construct such an automatic means would be derived if not from the prior art. This is equivalent to the Examiner rejecting the instant claims as not enabled, because they have not provided the details of a power supply for their device and maintaining the rejection, since inclusion of any of the well known power supply structures in the art would constitute new matter.

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Regarding the alleged deficiencies of the Imran reference, the Examiner will address the Swanson Declaration (hereafter "the Declaration") and then return to the arguments. The Examiner first note that since Dr . Swanson, (hereafter Declarant) is one of the instant inventors the Declaration as not by <sup>a</sup> disinterested third party. *Dr*

Declarant then opines that the Imran patent did not provide an enabling teaching of a catheter borne multiplexer chip. The argument is not convincing for several reasons. First of all, Declarant's opinion that such multiplexer chips did not exist in and itself is insufficient to rebut the existence of elements specifically recited in the prior art, even assuming that Declarant was an uninterested third party. Secondly these multiplexers are not merely discussed in the prior art, they are disclosed and claimed in an issued U.S. Patent. As such, the Declaration is insufficient to <sup>rebut</sup> ~~rebut~~ the presumption of validity afforded a U.S. Patent. Thirdly, even if Declarant provided *Dr* sufficient evidence to show that multiplexer chips <sup>as</sup> ~~are~~ described by Irman were in fact non- *Dr* existent at the time the instant invention was made, <sup>th</sup> ~~The~~ teachings of Imran would still be *Dr* sufficient to enable one having ordinary skill to replace the external switching means of Houser et al with an electronic one. For at least these reasons, the Declaration and applicants arguments based thereon are not persuasive.

Applicant's arguments filed March 27, 1998 have been fully considered but they are not persuasive. The set forth above

This is a CPA of applicant's earlier Application No. 08/529,354. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the

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grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MEP. § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

David Shay:bhw  
September 2, 1998  
September 14, 1998:kst  
(703) 308-2215



DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330